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EXAMINER

WIEKER, AMANDA FLYNN

ART UNIT PAPER NUMBER

3743

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,048

Applicant(s)

BAZIN ET AL.

Examiner

Amanda F. Wieker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-20, 24-48, 59, 61 and 62 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 21-23, 49-58, 60, 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In view of the Appeal Brief filed on 20 June 2005 and upon further consideration of the outstanding rejections, prosecution is reopened. The outstanding rejections are withdrawn. Rejections based on the newly cited reference(s) follow.

Specification

2. The amendment filed 15 May 2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The amendment entered on 15 May 2003 incorporates new matter. The language of claim 1 requiring the transfer image to not be fingerprints, and the external portion to not be a tooth, constitutes new matter. The specification as originally filed did not specifically exclude these elements as possible transfer images or external portions. There is no support in the originally filed specification for these negative limitations.

The portion of the amendment adding: "wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another" does not constitute new matter, as it is supported by at least the example of lipstick being transferred to a sheet of material (specification 5) after the external portion and transfer member are out of contact with one another.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3, 21-23, 49-51, 53-58 and 60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As described above, the language of independent claim 1 that requires the transfer image not be a fingerprint, and the external portion not be a tooth or teeth constitutes new matter. The specification as originally filed did not specifically exclude these elements, and does not provide support for this negative limitation.

Claims 3, 21-23, 49-51, 53-58 and 60 incorporate the new matter contained in claim 1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 52-53 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,343,536 to Groh.

Regarding claims 52-53 and 63, Groh discloses a process for acquiring scanned image data relating to an external body portion (skin) and/or a product applied to the external body portion (adhesive), the process comprising:

placing a transfer member (11) in contact with the external portion (skin with adhesive) so as to obtain a transfer image (16) on the transfer member,

wherein the transfer image (16) is present on the transfer member (11) after the transfer member (11) and the external portion are out of contact with one another (see Figure 4),

wherein the transfer image is not a fingerprint,

wherein the external body portion is not a tooth, and

scanning the transfer image with an optical image scanner (see column 4, lines 47-49) to obtain scanned image data for an image representative of at least one characteristic (cell and comedone presence, size, etc) of the external body portion and/or product,

wherein the process further comprises: scanning with the image scanner a calibration member (background lighting on microscope stage) having a predetermined color (see column 4, line 63 to column 5, line 21; The microscope stage is scanned along with the transfer member, and can be considered a calibration member. The background lighting of the microscope stage has a predetermined color value attributed to it before the image data is captured, to allow subsequent removal of said microscope stage lighting and coloring, to allow an image of the sample to be obtained.) The process is fully capable of being repeated to obtain data relating to multiple scanned images. The image scanner is fully capable of being used to scan documents.

Response to Arguments

7. Applicant's arguments with respect to claims 1-63 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

8. Claims 4-20, 24-48, 59 and 61-62 are allowed.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794.

The examiner can normally be reached on Monday-Thursday, 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


afw

Amanda F. Wieker
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